Remarks

Applicants thank the Examiner for kindly extending Applicants' Attorney, Brian L. Jarrells, the courtesy of a telephonic interview on August 9, 2006. During the interview claim 12 was discussed. No agreement was reached.

Claims 2, 3, 5, 7-12, 14-16, 18 and 20-22 have been amended and claims 1, 17 and 31-36 have been canceled. Support for the amendments to the claims can be found in general throughout Applicants' Specification, and in particular, for example, as follows: claim 12, original claim 1. No new matter has been added.

Applicants thank the Examiner for kindly withdrawing the rejection of claims 1 under 35 U.S.C. § 102(e) over Hornung et al. (U.S. 2004/0074588) (Hornung et al. '588) and claim 31 under 35 U.S.C. § 103 over Hornung et al. '588.

Applicants submit that the cancellation of claims 17 and 34-36 renders moot the rejection thereof under 35 U.S.C. § 112, second paragraph.

Regarding the statements in the June 27, 2006 Office action pertaining to the Declaration of Bing Wang, Applicants submit that the Declaration of Bing Wang , John Greenzweig and Mark Hackbarth, which is attached hereto overcomes the alleged deficiencies in the Declaration of Bing Wang. In addition, Applicants submit that both declarations established that Hornung et al. '588 is not a valid reference against the above-captioned application. In particular, the Declaration of Bing Wang, John Greenzweig and Mark Hackbarth establishes that Bing Wang, John Greenzweig and Mark Hackbarth had conceived and reduced to practice an insulating glass assembly, as well as a method of making an insulating glass assembly, prior to the filing date of Hornung et al. '588. Accordingly, Hornung et al. '588 is not a valid prior art reference to the above-captioned application. Applicants respectfully request entry of the Declaration of Bing Wang, John Greenzweig and Mark Hackbarth.

Previously pending claims 3, 5-8, 10, and 12-14 stand rejected under 35 U.S.C. § 102 over Reid et al. (U.S. 6,355,317).

Reid et al. disclose a one part edge sealant including a thermoplastic hot melt resin and a silicon-containing atmospheric curing resin. The thermoplastic hot melt resin can include a compound selected from the group consisting of solid chlorinated paraffin,

epoxidized soya oil, polyisobutylene and mixtures thereof. The atmospheric curing resin can include a compound selected from the group consisting of an alkoxy silane terminated polyurethane, an organo functional silane and mixtures thereof.

Claim 12, the first independent claim, is now directed to a process for making an insulating glass assembly that includes applying a moisture curable sealant composition to a surface of a spacer. The sealant composition includes silane-functional amorphous poly-α-olefin, butyl rubber, polyisobutylene, and tackifying agent. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. 2131. Reid et al. disclose an edge sealant including a thermoplastic hot melt resin and a silicon-containing atmospheric curing resin that polymerizes upon exposure to oxygen or water vapor in an ambient atmosphere (see, Reid et al., col. 4, lines 5-11). Reid et al. further disclose that the atmospheric curing resin can include a compound selected from the group consisting of an alkoxy silane terminated polyurethane, an organo functional silane and mixtures thereof (see, *Id.* at col. 4, lines 24-27). Additionally, Reid et al. disclose, "specific atmospheric curing resins include alkoxy, acetoxy, oxyamine silane terminated polyethers and polyether urethanes." *Id.* at col. 5, lines 56-58. A silane terminated polyurethane, polyether or polyether urethane is not a silane-functional amorphous poly-α-olefin. Reid et al. refer to organo functional silane compounds but do not teach what is meant by that term and do not provide any examples of the same. Moreover, organo functional silane compounds are not inherently polymers --let alone a silane-functional amorphous poly-α-olefin. Reid et al. also disclose that the thermoplastic polymer can be an interpolymer of ethylene with at least one C_3 to C_{20} alphaolefin (see, *Id.* at col. 8, lines 53-55). However, Reid et al. do not teach that their interpolymers include a silane-functional component. Thus, Reid et al. do not teach a silane-functional amorphous poly-α-olefin. Reid et al. also do not teach an actual composition that includes a silane-functional amorphous poly-α-olefin or a composition that includes silane-functional amorphous poly-α-olefin, butyl rubber, polyisobutylene and tackifying agent. As such, Reid et al. fail to teach each and every element of claim 12. Accordingly, the rejection of claim 12 under 35 U.S.C. § 102 over Reid et al. has been overcome and Applicants respectfully request that it be withdrawn.

Applicants submit that claim 13 is distinguishable under 35 U.S.C. § 102 over Reid et al. for at least the same reasons set forth above in distinguishing claim 12.

Applicants submit that the rejection of previously pending claims 3, 5-8, and 10 under 35 U.S.C. § 102 over Reid et al. has been rendered moot by the amendments to the same.

Applicants submit that the amendments to claims 9, 11, 18 and 20-22 render moot the rejection of previously pending claims 9, 11 and 18-22 under 35 U.S.C. § 103 over Reid et al., and respectfully request that it be withdrawn.

Applicants submit that the amendments to claims 15 and 16, which now depend from claim 12, render moot the rejection of previously pending claims 15 and 16 under 35 U.S.C. § 103 over Reid et al. in view of Hornung (U.S. 6,679,013).

Applicants submit that the amendments to claims 2 and 3, which now depend from claim 12, render moot the rejection of previously pending claims 2 and 4 under 35 U.S.C. § 103 over Reid et al. in view of the "Admitted Prior Art (page 2, lines 25-27) in the present specification", and respectfully request that it be withdrawn.

Previously pending claims 3, 5-14 and 16-22 stand rejected under 35 U.S.C. §103 over Hornung et al. (U.S. 2004/0074588) in view of Reid et al.

As a preliminary matter, Applicants submit that the amendment to claims 3, 5, 7-11, 14, 16, 18 and 20-22, which now depend from claim 12, render moot the rejection of previously pending claims 3, 5-11, 14-16, 18 and 20-22 under 35 U.S.C. § 103 over Hornung et al. (U.S. 2004/0074588) in view of Reid et al. and respectfully request that it be withdrawn.

We now turn to the rejection as it pertains to claims 12 and 13.

Hornung et al. '588 disclose a method for fabricating an integrated sash insulating glass unit. The sash frame can include a first mounting surface for a first glazing pane and a second mounting surface for a second glazing pane. The glazing panes are mounted to their respective surfaces using an adhesive sealant.

The discussion of Reid et al. set forth above is incorporated herein.

Claim 12 is now directed to a process for making an insulating glass assembly that includes applying a moisture curable sealant composition to a surface of a spacer, the sealant composition including silane-functional amorphous poly-α-olefin, butyl rubber,

polyisobutylene and tackifying agent. "Patent application publications having an effective prior art date prior to the application being examined may be used in a rejection of the claims." M.P.E.P. 715. However, "Applicant may overcome a 35 U.S.C. 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references...." M.P.E.P. 715.02. Prior to October 21, 2002, the filing date of Hornung et al. '588, Applicants developed a cold press sealant composition and had a manufacturer prepare an insulating glass unit by applying the cold press sealant composition to a surface of a spacer, contacting the sealant composition with glass panes, and applying pressure on the assembly at room temperature to bond the glass panes to the spacer through the sealant composition (see, Declaration of Bing Wang, John Greenzweig and Mark Hackbarth, which is attached hereto as Exhibit A. Hereinafter "the Declaration"). Applicants submit that the Declaration establishes that Hornung et al. '588 is not a valid reference against the above-captioned application. In particular, the Declaration establishes that Bing Wang, John Greenzweig and Mark Hackbarth had conceived and reduced to practice an insulating glass assembly, as well as a method of making an insulating glass assembly, prior to the filing date of Hornung et al. '588. Applicants submit, therefore, that Hornung et al. '588 is not available as a prior art reference against the above-captioned application. For this reason alone Applicants submit that the rejection of claims 12 and 13 under 35 U.S.C. § 103 over Hornung et al. '588 in view of Reid et al. is unwarranted and respectfully requests that it be withdrawn.

Claim 12 is further distinguishable under 35 U.S.C. § 103 over Hornung et al. '588 in view of Reid et al. for at least the following additional reasons. In order to establish a *prima facie* case if obviousness, "the prior art reference (or references when combined) must teach or suggest all of the claim limitations." M.P.E.P. 2142. Even assuming *arguendo* that Hornung et al. '588 is an available prior art reference, which Applicants in no way concede, Hornung et al. '588 do not teach or suggest a sealant composition that includes a silane-functional amorphous poly-α-olefin, butyl rubber, polyisobutylene and tackifying agent, as required by claim 12.

Reid et al. do not cure the deficiencies of Hornung et al. '588. As has been established above, Reid et al. do not teach or suggest a silane-functional amorphous poly-

α-olefin, a composition that includes a silane-functional amorphous poly-α-olefin or a composition that includes silane-functional amorphous poly-α-olefin, butyl rubber, polyisobutylene and tackifying agent. Moreover, nothing in Reid et al. directs the skilled artisan to form a sealant composition that includes a silane-functional amorphous poly-α-olefin. Thus, the proposed combination of Hornung et al. '588 and Reid et al. lacks a required element of claim 12. Accordingly, the rejection of claim 12 under 35 U.S.C. §103 over Hornung et al. '588 in view of Reid et al. is unwarranted and Applicants respectfully request that it be withdrawn. Should this rejection be maintained, Applicants respectfully request that the next action identify, by citation to column and line number, the location in Reid et al. where there is a teaching or suggestion of a silane-functional amorphous poly-α-olefin and a sealant composition that includes a silane-functional amorphous poly-α-olefin.

Claims 3, 5-14, 16 and 18-22, which depend either directly or indirectly from claim 12, are distinguishable under 35 U.S.C. §103 over Hornung et al. '588 in view of Reid et al. for at least the same reasons as set forth above in distinguishing claim 12.

Applicants submit that the amendments to claims 2 and 3, which now depend from claim 12, render moot the rejection of previously pending claims 2 and 4 under 35 U.S.C. § 103 over Hornung et al. and Reid et al. and further in view of the "Admitted Prior Art (page 2, lines 25-27) in the present specification", and respectfully request that it be withdrawn.

Applicants submit that the amendments to the claims render moot the rejection of claims 3, 6-11, 16, 18, and 20-22 over Hornung et al. '588 in view of Virnelson et al. (U.S. 5,849,832) or alternatively Virnelson et al. in view of Hornung et al. '588, and respectfully request that it be withdrawn.

Applicants submit that the amendments to the claims render moot the rejection of claims 2 and 4 under 35 U.S.C. § 103 over Hornung et al. '588 and Virnelson et al., or alternatively Virnelson et al. and Hornung et al. '588, in further view of the "Admitted Prior Art," and respectfully request that it be withdrawn.

Applicants submit that the amendments to the claims render moot the rejection of claim 5 under 35 U.S.C. § 103 over Hornung et al. '588 and Virnelson et al., or

alternatively Virnelson et al. and Hornung et al. '588, in further view of Briese et al. (U.S. 2002/0069823), and respectfully request that it be withdrawn.

Previously pending claims 12-13 and 19 stand rejected under 35 U.S.C. § 103 over Hornung et al. '588 and Virnelson et al., or alternatively Virnelson et al. and Hornung et al. '588, in further view of Wey et al. (U.S. 5,994,474).

Hornung et al. '588 disclose a method for fabricating an integrated sash insulating glass unit. The sash frame can include a first mounting surface for a first glazing pane and a second mounting surface for a second glazing pane. The glazing panes are mounted to their respective surfaces using an adhesive sealant.

Virnelson et al. disclose an edge sealant that includes a thermoplastic hot melt resin an atmospheric curing resin. The atmospheric curing resin can include alkoxy silane terminated polyurethanes, alkoxy silane terminated polyethers and polydimethylsiloxane polymers.

Wey et al. disclose an adhesive composition that includes a silane-grafted, largely amorphous poly-α-olefin.

As has been established above, and is incorporated herein by reference, Hornung et al. '588 is not available as a prior art reference to the above-captioned application. For this reason alone Applicants submit that the rejection of claims 12 and 13 under 35 U.S.C. § 103 over Hornung et al. '588 and Virnelson et al., or alternatively Virnelson et al. and Hornung et al.'588, in further view of Wey et al. is unwarranted and respectfully request that it be withdrawn.

Claim 12 is further distinguishable under 35 U.S.C. §103 over Hornung et al. '588 and Virnelson et al., or alternatively Virnelson et al. and Hornung et al. '588, in further view of Wey et al. for at least the following additional reasons. Even assuming *arguendo* that Hornung et al. '588 is an available prior art reference, which Applicants in no way concede, Hornung et al. '588 do not teach or suggest a sealant composition that includes a silane-functional amorphous poly-α-olefin, butyl rubber, polyisobutylene and tackifying agent, as required by claim 12.

Virnelson et al. do not cure the deficiencies of Hornung et al. In the June 27, 2006 Office action, the Examiner asserts, "Virnelson teaches the moisture curable sealant comprising the claimed components (column 3, line 59-column 4, line 38) but it is

unclear as to whether the composition includes a tackifying agent." June 27th Office action, p. 12. The June 27th Office action also asserts that Wey et al. generically teaches a sealant composition that includes a tackifying agent. See *Id.* Virnelson et al. do not disclose a sealant composition that includes a silane-functional amorphous poly-α-olefin --let alone a sealant composition that includes silane-functional amorphous poly-α-olefin, butyl rubber, polyisobutylene and tackifying agent. Rather, Virnelson et al. disclose that preferable atmospheric curing resins include "moisture cure polyurethanes, moisture cure polysulfides, polydimethylsiloxanes, oxygen cure polysulfides, and mixtures thereof, some containing silicon functionalities." Virnelson et al., col. 4, lines 18-21. Virnelson et al. also disclose that specific atmospheric curing resins include alkoxy, acetoxy, oxyamino silane terminated polyethers and polyether urethanes and alkyl siloxane polymers crosslinked with alkoxy, acetoxy, oxyamino organo functional silanes (see, *Id.* at col. 4, lines 21-25). A silane terminated polyether or polyether urethane is not a silane-functional amorphous poly-α-olefin. Virnelson et al. do not explain what is meant by their disclosure of alkyl siloxane polymers crosslinked with organo functional silane compounds and do not provide any examples of what is meant by the same. Moreover, organo functional silane compounds and alkyl siloxane polymers are not inherently silane-functional amorphous poly-α-olefins. Nothing in the record establishes anything to the contrary. Thus, Virnelson et al. do not teach a silane-functional amorphous poly-α-olefin. Additionally, nothing in Virnelson et al. directs the skilled artisan to form a sealant composition that includes a silane-functional amorphous poly-α-olefin. As such, Virnelson et al. does not teach or suggest a sealant composition that includes a silane-functional amorphous poly-α-olefin-let alone a sealant composition that includes a silane-functional amorphous poly-α-olefin, butyl rubber, polyisobutylene and tackifying agent, as required by claim 12. Therefore, since the premise on which the rejection of claim 12 under 35 U.S.C. § 103 over Hornung et al. '588 and Virnelson et al. and further in view of Wey et al. is based has been refuted, the rejection of claim 12 under 35 U.S.C. § 103 over Hornung et al. '588 and Virnelson et al. and in further view of Wey et al. has been overcome and Applicants respectfully request that the rejection be withdrawn.

Claims 13 and 19, which depend either directly or indirectly from claim 12, are distinguishable under 35 U.S.C. §103 over Hornung et al. '588 and Virnelson et al. and

further in view of Wey et al. for at least the same reasons as set forth above in distinguishing claim 12.

Applicants submit that the amendments to the claims render moot the rejection of claims 14 and 15 under 35 U.S.C. § 103 over Hornung et al. '588 and Virnelson et al., or alternatively Virnelson et al. and Hornung et al. '588 and further in view of Hornung '013, and respectfully request that it be withdrawn.

Claims 3, 6-13, 16 and 18-22 stand rejected under 35 U.S.C. § 103 over Hornung et al. '588 in view of Wey et al. and in further view of Virnelson et al., or alternatively Wey et al. in view of Hornung et al. '588 and in further view of Virnelson et al.

Hornung et al. '588 disclose a method for fabricating an integrated sash insulating glass unit. The sash frame can include a first mounting surface for a first glazing pane and a second mounting surface for a second glazing pane. The glazing panes are mounted to their respective surfaces using an adhesive sealant.

Wey et al. disclose an adhesive composition that includes a silane-grafted, largely amorphous poly-α-olefin.

Virnelson et al. disclose an edge sealant that includes a thermoplastic hot melt resin an atmospheric curing resin. The atmospheric curing resin can include alkoxy silane terminated polyurethanes, alkoxy silane terminated polyethers and polydimethylsiloxane polymers.

As has been established above, and is incorporated herein by reference, Hornung et al. '588 is not available as a prior art reference to the above-captioned application. For this reason alone Applicants submit that the rejection of claims 3, 6-13, 16 and 18-22 under 35 U.S.C. § 103 over Hornung et al. '588 in view of Wey et al. and in further view of Virnelson et al., or alternatively Wey et al. in view of Hornung et al. '588 and in further view of Virnelson et al. is unwarranted and respectfully requests that it be withdrawn.

Claim 12 is further distinguishable over the proposed combinations of Hornung et al. '588, Wey et al. and Virnelson et al. for at least the following additional reasons. Even assuming *arguendo* that Hornung et al. '588 is an available prior art reference, which Applicants in no way concede, Hornung et al. '588 do not teach or suggest a

sealant composition that includes a silane-functional amorphous poly-α-olefin, butyl rubber, polyisobutylene and tackifying agent, as required by claim 12.

Further regarding claim 12, the Examiner asserts, "Wey teaches all the limitations (column 2, lines 21-22; column 3, lines 22-58) but it is unclear as to whether the composition includes polyisobutylene." June 27th Office action, p. 15. The Examiner cited to Virnelson et al. for teaching a sealant composition that includes polyisobutylene. Wey et al. do not mention polyisobutylene anywhere in their disclosure and further fail to teach or suggest a sealant composition that includes polyisobutylene. Wey et al. also do not teach or suggest a sealant composition that includes a silane-functional amorphous poly-α-olefin, butyl rubber, and tackifying agent. Rather, Wey et al. disclose a silane-grafted poly-α-olefin (see, Wey et al., col. 2, lines 21-45). Wey et al. also disclose, "it is possible to add to the silane-grafted poly-α-olefin further substances which are conventionally used to establish the desired adhesive properties...." *Id.* at col. 3, lines 25-27. Wey et al. then proceed to disclose a long list of optional substances including tackifier resins, waxes, other polymers, plasticizers, thermal stabilizers, light stabilizers, optical brighteners, antistats, lubricants, fillers, dyes, pigments, antiblocking agents, nucleating agents and flame retardants (see, *Id.* at col. 3, lines 28-35). Wey et al. disclose that suitable "other polymers" include rubbers such as butyl rubber or SEBS or polyolefins (see, *Id.* at col. 3, lines 53-55). None of the example compositions of Wey et al. include a silane-functional amorphous poly-α-olefin, butyl rubber, and tackifying agent. Nothing in the disclosure of Wey et al. directs the skilled artisan to select a silane-functional amorphous poly-α-olefin, butyl rubber, and tackifying agent for use in a sealant composition. Thus, Wey et al. do not actually teach a composition that includes silane-functional amorphous poly-α-olefin, butyl rubber, and tackifying agent. Wey et al. also do not suggest such a composition. Rather, to arrive at a composition that includes silane-functional amorphous poly-α-olefin, butyl rubber, and tackifying agent from Wey et al. the skilled artisan would have to make a series of decisions and selections. In particular, the skilled artisan would need to 1) decide to include an optional substance in the composition, 2) decide to include more than one optional substance in the composition, 3) select a tackifier resin from the long list of optional substances, 4) decide to include an additional polymer in the composition, and 5) select butyl rubber from the

list of additional polymers. Nothing in Wey et al. directs the skilled artisan to make these particular selections. Moreover, the mere fact that the skilled artisan would have to make these selections demonstrates that Wey et al. do not teach a sealant composition that includes a silane-functional amorphous poly-α-olefin, butyl rubber, and tackifying agent. Accordingly, the premise on which the rejection of claim 12 under 35 U.S.C. § 103 over Hornung et al. '588 in view of Wey et al. and in further view of Virnelson et al., or alternatively Wey et al. in view of Hornung et al. '(588) and in further view of Virnelson et al. is based is not well founded.

Virnelson et al. do not cure the deficiencies of Hornung et al. and Wey et al. Nothing in Virnelson et al. directs the skilled artisan to modify the composition of Wey et al. so as to include silane-functional amorphous poly-α-olefin, butyl rubber, polyisobutylene, and tackifying agent. In particular, nothing in Virnelson et al. directs the skilled artisan 1) select a tackifier resin from the long list of optional components of Wey et al., 2) decide to include an additional polymer from the long list of optional components of Wey et al., 3) select butyl rubber as the additional polymer and 4) then *sua sponte* decide to further include polyisobutylene in the composition of Wey et al. Accordingly, the skilled artisan would have no reason to do so. Applicants submit, therefore, that the rejection of claim 12 under 35 U.S.C. § 103 over Hornung et al. '588 in view of Wey et al. and in further view of Virnelson et al., or alternatively Wey et al. in view of Hornung et al. '(588) and in further view of Virnelson et al. has been overcome and Applicants request that it be withdrawn.

Claim 3, 6-11, 13, 16 and 18-22 are distinguishable under 35 U.S.C. § 103 over Hornung et al. '588 in view of Wey et al. and in further view of Virnelson et al., or alternatively Wey et al. in view of Hornung et al. '588 and in further view of Virnelson et al. for at least the same additional reasons as set forth above in distinguishing claim 12.

Applicants submit that the amendments to the claims render moot the rejection of claims 2 and 4 under 35 U.S.C. § 103 over Hornung et al. '588 in view of Wey et al. and Virnelson et al. or alternatively Wey et al., Hornung et al. '588 and Virnelson et al. and further in view of the "Admitted Prior Art," and respectfully request that the rejection be withdrawn.

Applicants submit that the amendments to the claims render moot the rejection of claim 5 under 35 U.S.C. § 103 over Hornung et al. '588 in view of Wey et al. and Virnelson et al., or alternatively Wey et al., Hornung et al. '588 and Virnelson et al. and further in view of Briese et al., and respectfully request that the rejection be withdrawn.

Applicants submit that the amendments to the claims render moot the rejection of claims 14 and 15 under 35 U.S.C. § 103 over Hornung et al. '588, Wey et al. and Virnelson et al., or alternatively, Wey et al., Hornung et al. '588 and Virnelson et al. and further in view of Hornung '013, and respectfully request that the rejection be withdrawn.

Applicants submit that the amendments to the claims render moot the rejection of claims 3, 7-9, 11, 14 and 18-22 under 35 U.S.C. § 103 over Virnelson et al. in view of Glover et al. (U.S. 4,831,799), and respectfully request that the rejection be withdrawn.

Applicants submit that the amendments to the claims render moot the rejection of claims 6, 10 and 35 under 35 U.S.C. § 103 over Virnelson et al. and Glover et al and further in view of Bowser et al. (U.S. 3,919,023) and Glover et al (U.S. 6,401,428), and respectfully request that the rejection be withdrawn.

Applicants submit that the amendments to the claims render moot the rejection of claim 16 under 35 U.S.C. 103 over Virnelson e t al and Glover et al. '799 in view of Hornung '013, and respectfully request that the rejection be withdrawn.

Applicants submit that the amendments to the claims render moot the rejection of claims 3, 7-9, 11, 14 and 18-22 under 35 U.S.C. § 103 over Wey et al. in view of Glover et al. '799 and further in view of Virnelson et al., and respectfully request that the rejection be withdrawn.

Applicants submit that the amendments to the claims render moot the rejection of claims 6, 10 and 35 under 35 U.S.C. § 103 over Wey et al., Glover et al. '799 and Virnelson et al. and further in view of Bowser et al. and Glover et al. '428, and respectfully request that the rejection be withdrawn.

Applicants submit that the amendments to the claims render moot the rejection of claim 16 under 35 U.S.C. § 103 over Wey et al., Glover '799 and Virnelson et al. and further in view of Hornung '013, and respectfully request that the rejection be withdrawn.

Applicants further submit that any statements set forth in the June 27, 2006 Office action to the extent not expressly refuted herein, are hereby expressly refuted and

disagreed with. To the extent that the Office action contains assumptions about the state of the art, Applicants express their disagreement with the same and respectfully request evidence establishing the veracity of the same.

The Commissioner is hereby authorized to charge any additional fees that may be required and to credit any overpayment to Deposit Account No. 501,171.

Respectfully submitted,

Date: September 27, 2006

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